



Attorney's Docket No. 032592-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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|-----------------------------|---|------------------------------|
| In re Patent Application of |) | |
| Avram Glazer |) | Group Art Unit: 3627 |
| Application No.: 09/545,875 |) | Examiner: JOSEPH A FISCHETTI |
| Filed: April 7, 2000 |) | Appeal No.: |
| For: SYSTEM OF CONSISTENT |) | |
| INTERNET WEB SITE BANNERS |) | |
| THAT PROVIDE PORTAL-LIKE |) | |
| FUNCTIONALITY |) | |

APPEAL BRIEF

Mail Stop APPEAL BRIEF - PATENTS

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This appeal is from the decision of the Primary Examiner dated March 8, 2005 (Paper No. , finally rejecting claims 1-14, 44-50, which are reproduced as the Claims Appendix of this brief.

- ☐ A check covering the ☐ \$250.00 (2402) ☐ \$500.00 (1402)
Government fee is filed herewith.
- ☒ Charge ☒ \$250.00 (2402) ☐ \$500.00 (1402) to Deposit Account No. 02-4800.

The Commissioner is hereby authorized to charge any appropriate fees under 37 C.F.R. §§1.16, 1.17, and 1.21 that may be required by this paper, and to credit any overpayment, to Deposit Account No. 02-4800.

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I. Real Party in Interest

The present application is assigned to Zap.Com Corporation.

II. Related Appeals and Interferences

The Appellant's legal representative, or assignee, does not know of any other appeal or interference which will affect or be directly affected by or have bearing on the Board's decision in the pending appeal.

III. Status of Claims

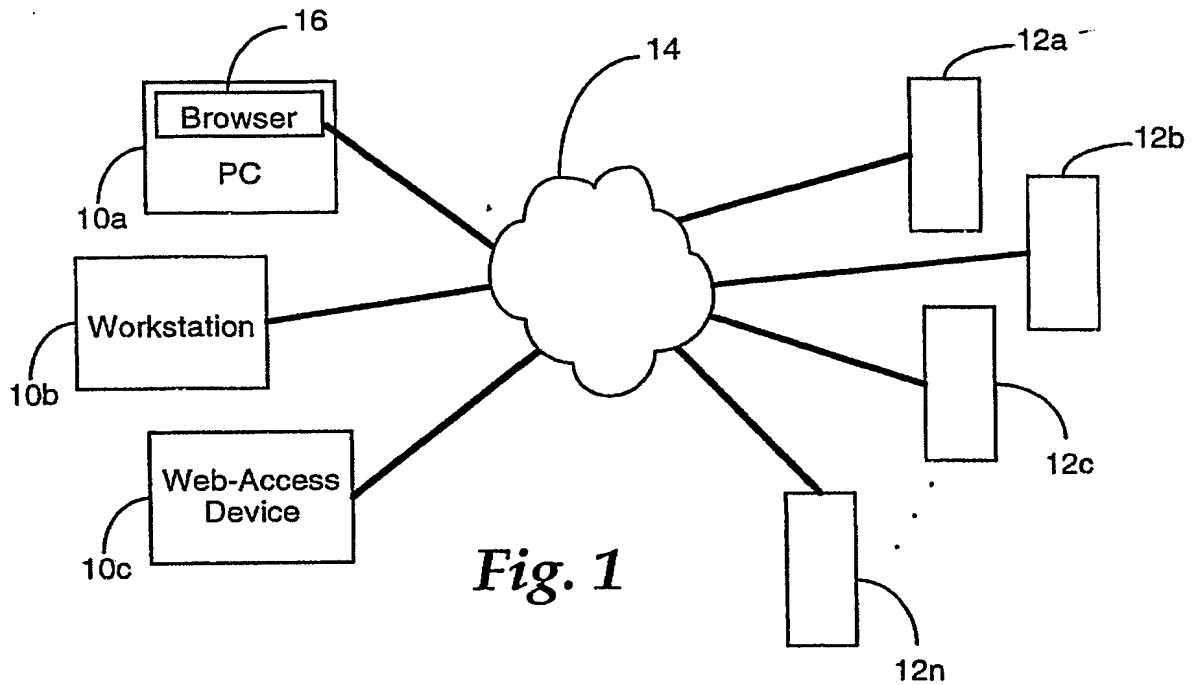
Claims 1-14 and 43-50 remain pending in the application. Claims 15-42 have been canceled. Claims 47-50 have been added by amendment filed November 18, 2004. Support for claims 47-49 appears, for example, at specification page 11, lines 1-7 and page 13, line 26 to page 14, line 18; and for claim 50 at page 8, lines 14-23.

IV. Status of Amendments

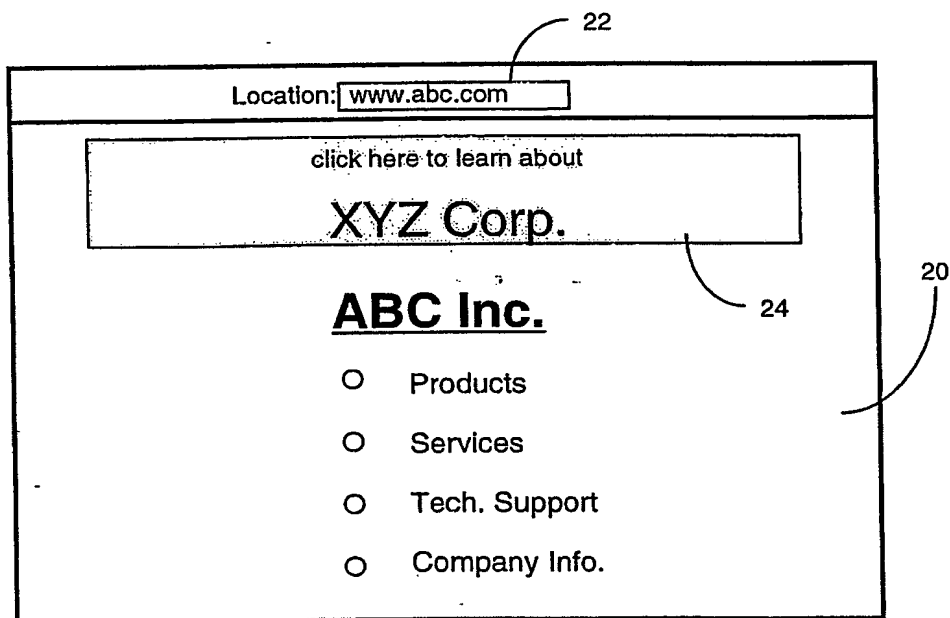
All Amendments have been entered.

V. Summary Of Claimed Subject Matter

Appellants' Figure 1 shows an exemplary networked computer system, as described at specification page 5, lines 3-9, wherein communication devices 10a-c are connected to servers 12a-n by a communication network 14 such as the Internet.



An exemplary banner published at one site (e.g., at server 12a) receives content published at a different site (e.g., server 12c), as illustrated in Figure 2.



In Figure 2, a web page 20 of web publisher ABC, Inc., whose web site may be hosted on first server 12a, is illustrated. As described at specification page 6, lines 3-8, a banner 24 published on a different web site XYZ Corp., may be hosted on a different server 12c. Instructions within the code for web page 20 are used to display the banner, and include a reference to the source of information for the banner (e.g., an address associated with server 12c), at which a file containing additional code for specifying contents of the banner 24 are resident. (see, e.g., specification page 6, lines 8-13).

An exemplary banner can provide access to multiple different services and thereby function as a multi-site/multi-function portal for the user. (Specification page 8, lines 14-23). An exemplary banner 24 includes a menu for affording the user access to various categories of content available through the party which has acquired the right to display and control the contents of the banner.

The foregoing features are broadly encompassed by independent claim 1, which is directed to a method for providing multiple types of content for users of the Internet. Claim 1 recites a step of storing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services. Claim 1 recites establishing a connection between said file and at least one web page that is displayed at an Internet web site stored on a second server; and causing at least some of the contents of said file to appear within a banner displayed within the web page at a communications device whenever the communications device, interfaced with the file server and the second server, downloads said page from the display.

Exemplary embodiments of the present invention can provide numerous advantages. Exemplary embodiments provide a tool for building a network of interconnected Internet sites as described at specification page 3, lines 6-25, and at specification page 16, lines 1-9. By establishing connections between a file stored on a file server and web pages displayed at multiple Internet web sites, multiple web pages displayed at multiple web sites can access common banner content. This can provide increased access to the banner content and decrease the access cost the various web page hosts incur for displaying the banner content. The banner content can include valuable information which numerous web page hosts would have an interest in displaying to attract interest to their sites. For example, a virtual network of sites can be tied together using a common banner, thus increasing the value of all sites participating in the virtual network.

VI. Grounds of Rejection to be Reviewed on Appeal

A. On numbered page 2 of the Final Office Action, claims 1-14 and 43-46 are rejected under 35 U.S.C. §112, second paragraph, as being indefinite. The Examiner asserts that claim 1 is indefinite because it recites that the communication device interfaces with both the file server and the second server.

B. On page 2 of the Final Office Action, claims 1 and 44 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Patent No. 6,336,131 (Wolfe).

C. On pages 3-5 of the Final Office Action, claims 1-14 and 44-46 are rejected under 35 U.S.C. §103 as being unpatentable over the Wolfe '131 patent in view of U.S. Patent No. 6,643,696 (Davis). The Examiner has taken "Official Notice" with respect to what is asserted as the "old and notorious use of scrolling, a search

function linking to products on a [manufacturer's] site and graphic manuals, as well as the feature of the headlines being stored in a file that is downloaded to a user's site when the user selects the category associated with the headlines." On page 4, the Examiner relies upon newly cited U.S. Patent No. 6,496,843 (Getchius et al) to support the "Official Notice."

VII. Argument

A. Claim 1 Is Definite Such That The Rejection Under 35 U.S.C. §112 Is Improper

The objection to claim 1 under 35 U.S.C. §112, second paragraph is respectfully traversed, because Appellants' specification provides clear support for information stored at a file server, and information stored at a second server, being made available to the communications device whenever the communications device downloads the page for display. For example, specification page 6, lines 8-13 describe an exemplary embodiment wherein a banner 24 is displayed by means of instructions within the HTML code for the web page 20. The inclusion of the instructions within the HTML code of the web page supports Appellants' claim 1 function whereby contents of a file on a file server will appear within a banner display within a web page at a communications device **whenever** the communications device downloads the page for display. Specification page 7, line 14 describes an exemplary banner is immediately visible "**whenever** a user accesses the web page." (Emphasis added). Specification page 13, lines 19-22 describes an operation whereby a user, via a communications device, can access a file at a banner party's

site such that the user can customize a banner that will appear in a web page hosted by a second server.

In light of the foregoing comments, the specification can be seen to clearly support a communication device which interfaces with multiple servers such that reversal of the Examiner's objection under 35 U.S.C. §112, is requested.

B. The Examiner Has Failed To Establish That All Features Recited In Claims 1 and 44 Are Taught By The Wolfe Patent.

The foregoing rejections raised under 35 U.S.C. §102 are respectfully traversed because the Wolfe patent fails to teach, among other features, "establishing" the connection recited in claim 1, or "causing" at least some of the contents of a file (stored on a file server) to appear within a banner displayed within a web page (stored on a second file server) at a communications device **whenever** the communications device downloads the page for display, as recited in claim 1.

Systems and methods described in the Wolfe patent transfer information sequentially from a server to an end user (e.g., to the desktop computer of an end user), and do not establish a connection between at least one file on at least one file server and a web page displayed at an Internet web site stored on a second server.

The Wolfe patent is directed to a system and method for communicating information to a user by requiring the user to separately, sequentially access multiple servers. Rather than being a site based system for combining content from multiple servers for display on a user's communications device, the Wolfe patent is a user-focused approach, as illustrated in Wolf's Figure 5:

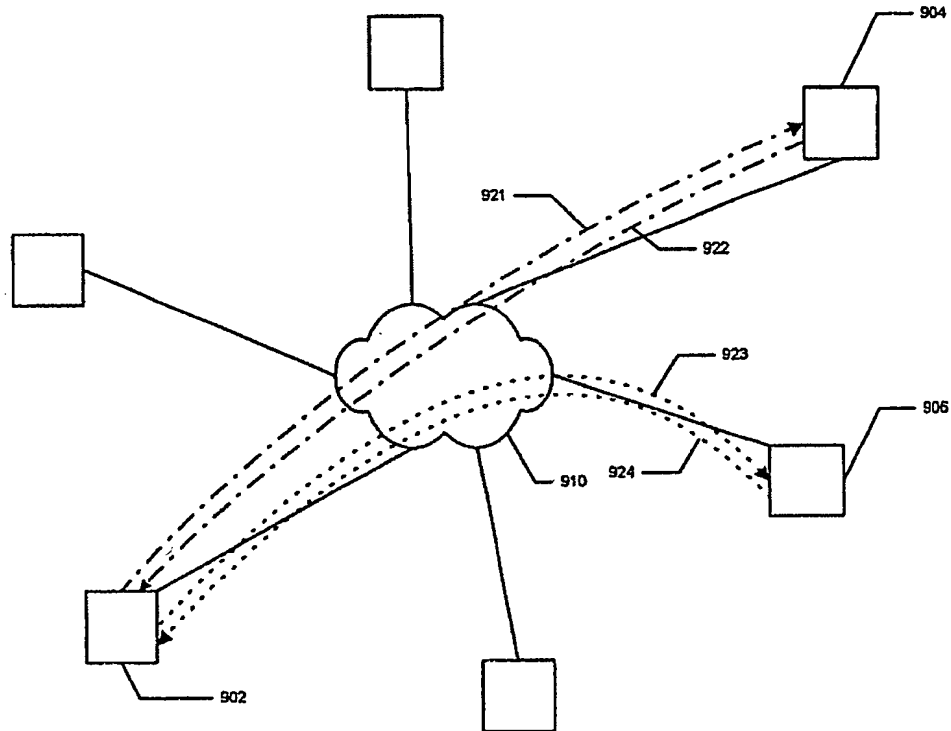


Figure 5

Figure 5 of the Wolfe patent requires that a user on a client computer 902 access another computer, such as web server 904, to download a document to the client 902. The Wolfe patent then requires the user to separately access a computer, such as computer 906. Referring to Figure 5 of the Wolfe patent and column 6, lines 46-55, information sent by the client to computer 906 includes information regarding the server 904 from which a displayed document has been retrieved as well as the identity of the document or resource on server 904 that is being displayed at the client 902. Upon receipt of information from the client

computer 902, the computer 906 can determine if there is supplemental information available for this particular document as described at column 6, lines 56-65. If so, computer 906 includes the supplemental information in its response to the client 902.

Thus, the client computer 902 of the Wolfe patent separately and sequentially requests information from multiple servers. In contrast to Appellants' presently claimed invention, the Wolfe patent does not teach or suggest causing at least some of the contents of a file to appear within a banner displayed within a web page at a communications device **whenever** the communications device (interfaced with a file server that stores the file and a second server that stores the web page) downloads the page for display. As such, claim 1 is allowable over the Wolfe patent.

On pages 5-6 of the Final Office Action, the Examiner sets forth a response to Appellants' prior arguments, and states:

Applicant's arguments filed 11/18/04 have been fully considered but they are not persuasive. Applicant argues that Wolfe does not read on claim 1. However, the examiner finds that the disclosure of Wolfe reads on claim 1. The best place to understand how Wolfe reads on claim 1 is to refer to Figs. 31 and 32. In Fig. 31, a web page is loaded from the Hunan Taste server 904. The file server is read as the reference server 906 which controls access to supplemental data such as interfaced in Fig. 32 by the banner the Oriental Specialties contents. The banner is read as the contents box 3305 in Fig. 32. The banner 3305 is caused to appear on the Hunan Taste web page whenever the communication device 902 interfaces with servers 906 and 904 as a result of reference server 906 finding supplemental data which is to appear on web page Hunan taste server 904. Thus, the term "whenever" does cover the case where there is supplemental data accessed by server 906 and thus it reads on claim 1.

Regarding the 112 second rejection, it is still unclear whether interfacing occurs through access first through the second server and ultimately to the second server. It is the examiner's position that both

servers cannot be access[ed] simultaneously as the examiner interprets the claim to read.

The Examiner's §102 rejection thus appears to be based, at least in part, on that improper rejection under 35 U.S.C. §112. The §112 rejection having been addressed herein, claim 1 is allowable.

Moreover, Figs. 31 and 32 of Wolfe show a web page (i.e., Hunan taste web page) displayed in browser window 2901 of a client browser. Fig. 32, which includes all features of Fig. 31, is illustrated below:

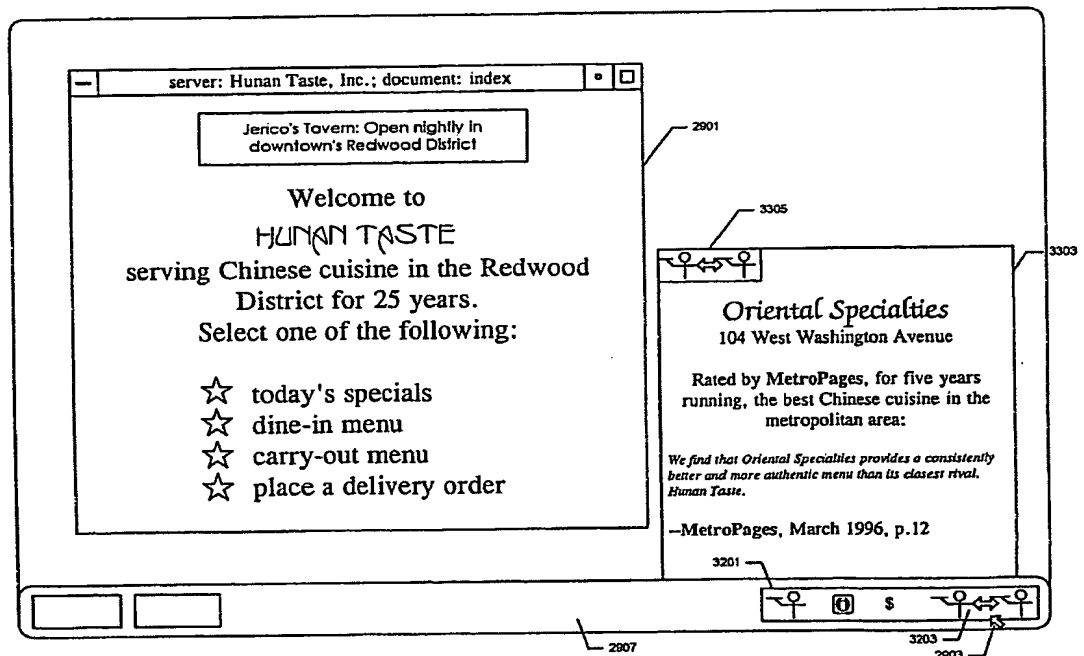


Figure 32

Contrary to the presently claimed invention, the display element 3305 of Fig 32 is not displayed as part of the Hunan Taste web page, as is apparently alleged by the Examiner. Rather, the display element 3305 is displayed in a separate window

3303. Accordingly, contents of a file do not appear within any banner displayed within a web page at a communications device whenever the communications device downloads said page for display, as recited in Appellants' claim 1.

As such, claim 1 and dependent claim 44 are allowable.

C. The Examiner Has Failed To Establish A Prima Facie Case Of Obviousness In Rejecting Claims 1-14 and 44-50 Over A Combination of The Wolfe Patent, The Davis Patent And The Getchius et al Patent

The Davis patent, and the newly relied upon Getchius patent, fail to overcome the already described deficiencies of the Wolfe patent such that these patents, even if combined in the manner suggested by the Examiner, fail to teach or suggest the presently claimed invention.

The Davis patent is directed to tracking client interaction with a network resource, and to creating client profiles and a resource database. The Davis patent describes tracking the time a user spends on a website interacting with an advertising banner, and reporting back this information. Column 14, lines 16-57 of the Davis patent describes using this information to permit a server to assemble a web page or target an advertising banner based upon a user profile. However, the Davis patent does not teach or suggest causing at least some of the contents of a file to appear within a banner displayed within a web page at a communications device **whenever** the communications device downloads the page for display.

A combination of features described in the Davis patent with those of the Wolfe patent would, at best, have resulted in a mechanism for measuring the time associated with viewing each page of a website displayed at a client computer 902 of

the Wolfe patent. Neither the Wolfe patent nor the Davis patent are directed to networking multiple sites so that content from multiple sites can be combined and accessed by a user's communications device whenever the communications device downloads a web page for display, as recited in claim 1. As such, claim 1 is allowable.

The remaining dependent claims are allowable for reasons already discussed with respect to claim 1. Moreover, these dependent claims recite additional features which further distinguish over the patents relied upon by the Examiner.

For example, in the paragraph bridging pages 4-5 of the Final Office Action, the Examiner relies upon the Getchius patent, which was newly cited in the Final Office Action, to support assertions of "Official Notice" with regard to claims 2-5, 9-11, 13-14, 44-45 and 47-50. The Getchius patent fails to support any of the assertions of "Official Notice" for which it is relied upon by the Examiner. Moreover, this patent fails to overcome the deficiencies described herein with respect to the Wolfe and Davis patents.

Exemplary embodiments of the present invention permit a connection to be established between an additional file and an additional web page displayed on a second Internet website, with the content displayed being customized for each website, and provide for leasing of banner space. See, for example, claims 47-50. The Wolfe, Davis and Getchius patents fail to teach or suggest any such ability to customize contents of a file for display as a banner at each of multiple websites or for leasing banner space.

In light of the foregoing, all of Appellants' pending claims 1-14 and 43-50 are allowable over the Wolfe patent, considered alone or in combination with the Davis and Getchius patents.

VIII. Claims Appendix

See attached Claims Appendix for a copy of the claims involved in the appeal.

IX. Evidence Appendix

NONE

X. Related Proceedings Appendix


NONE.

Respectfully submitted,

Buchanan Ingersoll PC

Date Nov. 8, 2005

By: _____



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VIII. CLAIMS APPENDIX

The Appealed Claims

1. (Previously Presented) A method for providing multiple types of content for users of the Internet, comprising the steps of:

storing at least one file on at least one file server that provides Internet users with access to a plurality of different types of information and services;

establishing a connection between said file and at least one web page that is displayed at an Internet web site stored on a second server; and

causing at least some of the contents of said file to appear within a banner displayed within the web page at a communications device whenever the communications device, interfaced with the first file server and the second server, downloads said page for display.

2. (Original) The method of claim 1 wherein said banner provides access to a plurality of different categories of informational content.

3. (Original) The method of claim 2 wherein said categories are displayed to a user by means of a menu within said banner, and are individually selectable by the user from said menu.

4. (Original) The method of claim 3 wherein said banner displays individual headlines associated with a selected category of informational content.

5. (Original) The method of claim 4 wherein said individual headlines are displayed in a scrolling manner.

6. (Original) The method of claim 4 wherein said headlines are stored in a file that is downloaded to a user's site when the user selects the category associated with the headlines.

7. (Original) The method of claim 4 wherein each displayed headline comprises a link to a file which contains the content associated with the headline, and which is displayed to the user when the user clicks upon the headline while it is displayed.

8. (Original) The method of claim 4 wherein said banner further includes a link to cause all of the headlines associated with a selected category to be displayed for viewing by the user.

9. (Original) The method of claim 2 wherein said banner further includes a search function which enables a user to conduct a search from the banner for information of interest in the Internet.

10. (Original) The method of claim 2 wherein said banner further includes a community services category which presents a dialog box in which a user can enter text for viewing by other users and view text entered by other users.

11. (Original) The method of claim 2 wherein said banner further includes a link that provides access to a web site that contains a listing of product lines, and individual manufacturer information about products in each product line.

12. (Original) The method of claim 11 wherein said manufacturer information comprises graphical files of product brochures.

13. (Original) The method of claim 2, wherein said banner further includes a link that provides access to a web site that provides e-commerce services.

14. (Original) The method of claim 1 wherein said banner is configurable by users to display only selected items from the plurality of different information and services.

15. (Canceled)

16. (Canceled)

17. (Canceled)

18. (Canceled)

19. (Canceled)

20. (Canceled)

21. (Canceled)

22. (Canceled)

23. (Canceled)

24. (Canceled)

25. (Canceled)

26. (Canceled)

27. (Canceled)

28. (Canceled)

29. (Canceled)

30. (Canceled)

31. (Canceled)

32. (Canceled)

33. (Canceled)

34. (Canceled)

35. (Canceled)

36. (Canceled)

37. (Canceled)

- 38. (Canceled)
- 39. (Canceled)
- 40. (Canceled)
- 41. (Canceled)
- 42. (Canceled)
- 43. (Canceled)

44. (Previously Presented) The method of claim 1, wherein at least some of the contents are supplied by the file server directly to the communications device.

45. (Previously Presented) The method of claim 1, wherein the banner is configured by the user using the communications device.

46. (Previously Presented) The method of claim 1, wherein the banner provided by the second server includes a tag which points to a designated location of the file server to retrieve the contents of the file to the communications device.

47. (Previously Presented) The method of claim 1, wherein an additional file is stored on the file server, and a connection is established between the additional file and an additional web page that is displayed on a second Internet website.

48. (Previously Presented) The method of claim 47, wherein the contents of the at least one file and of the additional file are customized for each website.

49. (Previously Presented) The method of claim 48, wherein the contents are modified on the file server by at least one of the communications device and the second server to display only categories that are of interest to a user.

50. (Previously Presented) The method of claim 1, wherein a portion of the contents which appear within the banner are provided by a third party which leases banner space from an owner of the banner space.

IX. EVIDENCE APPENDIX

NONE

X. RELATED PROCEEDINGS APPENDIX

NONE